| FACSIMILE TRANSMITTAL FORM | Application Number | 10/613,231 |
|---|---|---|
| | Filing Date | July 3, 2003 |
| | First Named Inventor | Everaerts, Albert I. |
| | Art Unit | 1713 |
| | Examiner Name | Tatyana Zalukaeva |
| Fax: 703-872-9306 | Attorney Docket Number | 58851US002 |
| Total Number of Pages in This Submission: 4 | | |
| Date: January 5, 2005 | Patent Agent for Applicant: Bradford B. Wright | |

**ENCLOSURES**
(check all that apply)

| | | |
|---|---|---|
| ☐ Fee Transmittal Form<br>☐ Issue Fee Transmittal<br>☐ Amendment Transmittal | ☐ Petition | ☐ Appeal Communication to Board of Appeals and Interferences |
| ☐ Amendment/Reply<br>☐ After Final<br>☐ Affidavits/Declaration(s) | ☐ Petition to Convert a Provisional Application | ☐ Appeal Communication to Technology Center (Appeal Notice, Brief, Reply Brief) |
| ☐ Extension of Time Request | ☐ Power of Attorney, Revocation | ☐ Proprietary Information |
| ☐ Express Abandonment Request | ☐ Change of Correspondence Address | ☐ Status Letter |
| ☐ Information Disclosure Statement | ☐ Terminal Disclaimer | ☒ Other Enclosures:<br>**Response to Restriction Requirement** |
| ☐ Response to Missing Parts/ Incomplete Application<br>☐ Response to Missing Parts under 37 CFR § 1.52 or 1.53 | ☐ Request for Refund<br>☐ Request for Continued Examination (RCE) Transmittal | |
| ☐ Drawings | ☐ After Allowance Communication to Technology Center | |

**REMARKS:**

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Patent
Case No.: 58851US002

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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|---|---|---|---|
| First Named Inventor: | EVERAERTS, ALBERT I. | | |
| Application No.: | 10/613,231 | Group Art Unit: | 1713 |
| Filed: | July 3, 2003 | Examiner: | Tatyana Zalukaeva |
| Title: | HEAT-ACTIVATABLE ADHESIVE | | |

## RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR § 1.8(a)]**

I hereby certify that this correspondence is being:

☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

☒ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 872-9306.

January 5, 2005 Kathleen M. Murray
Date Signed by: Kathleen M. Murray

Dear Sir:

This is in response to the Office Action mailed 12/08/2004.

This Response is believed to be timely submitted; however, if an extension of time is necessary one is hereby requested. It is believed that no fee is due; however, in the event a fee is required, please charge the fee to Deposit Account No. 13-3723.

**Restriction Requirement**

Claims 1-73 are pending.

Claims 1-73 stand restricted under 35 USC § 121 as follows:

I. Claims 1-30 are said to be drawn to a heat activatable adhesive, classified in Class 526, subclass 319;

II. Claims 31-39 are said to be drawn to a method of making a heat activatable adhesive, classified in Class 525, subclass 323+; and

III. Claims 40-57 are said to be drawn to an article, classified in Class 428, subclass various.

In response, Applicants elect the invention of Group I (claims 1-30), with traverse. Applicants note that although the Office Action Summary sheet indicates that claims 1-73 are restricted, the actual Restriction Requirement only restricts claims 1-57 (total of Groups I, II, and III). Applicants presume that claims 58-73 are not subject to restriction.

The Restriction Requirement in Item 2 asserts that Inventions II and I are related as process of making and product made. The Patent Office argues that the product as claimed can be made by a materially different process, such as polymerizing monomers on the surface of a substrate to be coated with simultaneous crosslinking.

Applicants respectfully submit that even in the event that the heat-activatable adhesive was made by polymerizing monomers on the surface of a substrate, it would still involve steps of a) providing a mixture of monomers; and b) polymerizing the mixture monomers. It is further submitted that the claims of Groups II and I are so interrelated that a search of one group of claims will reveal art to the other, and that the classification of Groups II and I claims in different classes and subclasses is not sufficient grounds to require restriction.

Similarly, it is submitted that a search for the heat activatable adhesive of Group I will reveal art related to the article of Group III, since the heat-activatable adhesive is incorporated into the article.

Were restriction to be effected between the claims in Groups II and I, or Groups I and III, a separate examination of the claims in Groups II and I, or the claims in Groups I and III, would require substantial duplication of work on the part of the U.S. Patent and Trademark Office.

Even though some additional consideration would be necessary, the scope of analysis of novelty of all the claims of Groups II and I, or Groups I and III, would have to be as rigorous as when only the claims of Group I were being considered by themselves. Clearly, this duplication of effort would not be warranted where these claims of different categories are so interrelated. Further, Applicants submit that for restriction to be effected between the claims in Groups II and I, or of the claims in Groups I and III, it would place an undue burden by requiring payment of a separate filing fee for examination of the nonelected claims, as well as the added costs associated with prosecuting multiple applications and maintaining multiple patents.

In view of the above, reconsideration and withdrawal or modification of the restriction requirement is respectfully requested.

**Election of Species Requirement**

The Patent Office asserts that the application contains claims to the following distinct species of the claimed invention:

a) non-acidic polar monomer

b) alkyl (meth)acrylate having 4-20 carbon atoms

c) alkyl methacrylate having at least 20 carbon atoms

d) a heat activatable adhesive article (wherein the substrate is either film, or sheet or strip or thermoplastic polymer or paper with release coating).

The Patent Office requires Applicants to elect a single disclosed species for prosecution on the merits to which the claim shall be restricted, if no generic claim is finally held allowable. The Patent Office asserts that claims 1, 31, 40, and 41 are generic.

Without agreeing to the Patent Office's characterization of the above-identified species or admitting that the election of species requirement is even proper, but in order to comply with the requirement, Applicants hereby elect Species c). However, it is submitted that Species c) does not appear to be a proper species of the claimed invention. For example, none of claims 1-73 appear to read on Species c), and none of claims 1-73 appear to be generic to Species c). Reconsideration and withdrawal of the Election of Species Requirement is requested.

## Conclusion

Applicants have elected the invention of Group I with traverse. Applicants have elected Species c). Continued prosecution of this application is respectfully requested.

The Examiner is invited to contact the undersigned at the indicated telephone number with questions that can be resolved with a simple teleconference.

Respectfully submitted,

Jan. 05, 2005
Date

By: Bradford Wright
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Office of Intellectual Property Counsel
3M Innovative Properties Company
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